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BEST AVAILABLE COPYBRASCH *et al.*
Appl. No. 09/695,065**Remarks****I. Support for Amendments**

Support for the foregoing amendments to the claims and newly added claims may be found, *inter alia*, at page 22, line 29 to page 23, line 9, at page 34, lines 7-29, and throughout the specification as originally filed, either inherently or explicitly. Hence, the foregoing amendments to the claims and new claims do not add new matter.

The foregoing amendments to the claims are sought to place the claims in condition for allowance or into better form for consideration on appeal. The Examiner also suggested these amendments during the personal interview held on March 23, 2005. Hence, entry and consideration of these amendments after final are respectfully requested.

II. Status of the Claims

Upon entry of the foregoing amendments, claims 14-20, 27 and 32-79 are pending in the application, with claims 14, 16 and 44 being the independent claims. Claims 14, 16, 18-20 and 44 are currently amended. Claims 58 to 79 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

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Appl. No. 09/695,065**III. Summary of the Office Action**

In the Office Action dated February 23, 2005, the Examiner has made two rejections of the claims. All objections and rejections that were not reiterated from the previous Office Action dated October 27, 2004, were withdrawn. Applicants respectfully offer the following remarks to accommodate or traverse each of the outstanding rejections in the Office Action.

IV. Summary of Personal Interview on March 23, 2005

Applicants thank Examiners Frank Lu and Gary Jones for the courtesy of a personal interview with Applicants' representatives on March 23, 2005. Claims 14-20, 27, and 32-57 were discussed, as were the Stemmer, Atlung, and Hartley references. During the interview, the Examiner suggested that replacement of the term "integration sequences" with the term "mobile genetic elements" would be favorably received. The Examiner agreed to reconsider the cited references in light of the recitation of "mobile genetic elements" in the claims. The Examiner also agreed to withdraw the rejection over Hartley under 35 U.S.C. § 102(f).

V. The Rejection of Claims 14-20, 27, 32, 33, 44-46, and 57 under 35 U.S.C. § 102(b) Over Stemmer is Traversed

The Examiner has maintained the rejection of claims 14-20, 27, 32, 33, 44-46 and 57 under 35 U.S.C. § 102(b), for allegedly being anticipated by Stemmer (U.S. Patent No. 5,605,793; Doc. AB3, of record; hereinafter "Stemmer"). Office Action of February 25, 2005 (hereinafter "Office Action") at pages 3-10, section 3. Applicants respectfully traverse this rejection.

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The Examiner repeated the arguments set forth in the Office Action dated October 27, 2004, and further asserted that Applicants' arguments in the Reply filed January 27, 2005, were not persuasive. Applicants respectfully disagree with the Examiner's assertions for at least the reasons set forth in the Reply filed January 27, 2005, and the Applicants' other previous responses, which are reiterated and incorporated by reference herein. Nevertheless, as discussed during the March 23, 2005, interview, solely for the purposes of expediting prosecution and not in acquiescence to the Examiner's rejection, Applicants have amended the claims to recite "mobile genetic elements." Stemmer does not describe, either expressly or inherently, mobile genetic elements as that term is used and defined in the present specification and claims. As such, Stemmer does not disclose every element of the presently claimed methods.

Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 771 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984). Since, Stemmer does not expressly or inherently disclose the presently claimed methods, under *Kalman*, this reference cannot and does not anticipate the claims as currently presented.

In view of the foregoing remarks, reconsideration and withdrawal of the rejection of claims 14-20, 27, 32, 33, 44-46 and 57 under 35 U.S.C. § 102(b) over Stemmer are respectfully requested.

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Appl. No. 09/695,065**VI. The Rejection of Claims 14-20, 27, 32, 33, 44-46, and 57 under 35 U.S.C. § 102(b) Over *Atlung et al.* is Traversed**

The Examiner has also maintained the rejection of claims 14-20, 27, 32, 33, 44-46, and 57 under 35 U.S.C. § 102(b), for allegedly being anticipated under 35 U.S.C. § 102(b) by *Atlung et al.*, *Gene* 107: 11-17 (1991) (Doc. AT4, of record; hereinafter "*Atlung*"). *See* Office Action at pages 10-17, section 4. Applicants respectfully traverse this rejection.

The Examiner repeated the arguments set forth in the Office Action dated October 27, 2004, and further asserted that Applicants' arguments in the Reply filed January 27, 2005, were not persuasive. Applicants respectfully disagree with the Examiner's assertions for at least the reasons set forth in the Reply filed January 27, 2005, and the Applicants' other previous responses, which are reiterated and incorporated by reference herein. Nevertheless, as discussed during the March 23, 2005, interview, solely for the purposes of expediting prosecution and not in acquiescence to the Examiner's rejection, Applicants have amended the claims to recite "mobile genetic elements." *Atlung* does not describe, either expressly or inherently, mobile genetic elements as that term is used and defined in the present specification and claims.

As noted above, a claim can only be anticipated under 35 U.S.C. § 102 if every element in the claim is expressly or inherently disclosed in a single reference. *See Kalman*, 713 F.2d at 771. Since *Atlung* does not disclose all of the elements of the claimed methods, Applicants respectfully assert that *Atlung* cannot and does not anticipate the claims as currently presented. Reconsideration and withdrawal of the rejection of claims 14-20, 27, 32, 33, 44-46 and 57 under 35 U.S.C. § 102(b) over *Atlung* therefore are respectfully requested.

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VII. The Rejection of Claims 14-20, 27, 32-51 and 57 under 35 U.S.C. §§ 102 (a) or 102 (e) Over Hartley et al. is Traversed

The Examiner has also maintained the rejection of claims 14-20, 27, 32-51 and 57 under 35 U.S.C. §§ 102(a) or 102(e), for allegedly being anticipated by Hartley *et al.* (U.S. Patent No. 5,888,732); Doc. AF3, of record; hereinafter "Hartley"). *See* Office Action at pages 18-26, section 5. Applicants respectfully traverse this rejection.

The Examiner repeated the arguments set forth in the Office Action dated October 27, 2004, and further asserted that Applicants' arguments in the Reply dated January 27, 2005, were not persuasive. Applicants respectfully disagree with the Examiner's assertions for at least the reasons set forth in the Reply filed January 27, 2005, and the Applicants' other previous responses, which are reiterated and incorporated by reference herein. Nevertheless, as discussed during the March 23, 2005, interview, solely for the purposes of expediting prosecution and not in acquiescence to the Examiner's rejection, Applicants have amended the claims to recite "mobile genetic elements." Hartley does not describe, either expressly or inherently, a method of introducing recombination sites into a nucleic acid molecule by inserting mobile genetic element(s) comprising recombination sites as in the present claims.

As noted above, a claim can only be anticipated under 35 U.S.C. § 102 if every element in the claim is expressly or inherently disclosed in a single reference. *See Kalman*, 713 F.2d at 771. Since Hartley does not disclose all of the elements of the claimed methods, Applicants respectfully assert that Hartley cannot and does not anticipate the claims as currently presented. Reconsideration and withdrawal of the

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rejection of claims 14-20, 32-51 and 57 under 35 U.S.C. §§ 102(a) or 102(e) over Hartley are therefore respectfully requested.

VIII. The Rejection of Claims 14-20, 27, 32-39, 44-51 and 57 under 35 U.S.C. § 102(f) is Traversed

The Examiner has maintained the rejection of claims 14-20, 27, 32-39, 44-51, and 57 under 35 U.S.C. § 102(f). Office Action at pages 26-27, section 6. Applicants respectfully traverse this rejection.

Applicants respectfully maintain the arguments set forth in their previous replies, which are reiterated and incorporated by reference herein. However, as noted above in the Summary of Personal Interview of March 23, 2005, the Examiner has agreed to withdraw the rejection of claims 14-20, 27-39, 44-51 and 57 under 35 U.S.C. § 102(f). Reconsideration and withdrawal of the rejection of claims 14-20, 27, 32-39, 44-51, and 57 under 35 U.S.C. § 102(f) are therefore respectfully requested.

IX. The Rejection Under the Judicially Created Doctrine of Obviousness-Type Double Patenting is Traversed

The Examiner has maintained the rejection of claims 14-20, 27, 32-39, 44-51 and 57 under the judicially created doctrine of obviousness-type double patenting over certain claims in Hartley. Office Action at pages 27-29, sections 7-8. Applicants respectfully traverse this rejection.

For at least the reasons discussed in the previous Reply filed January 27, 2005, and Applicants' other previous responses, which are reiterated and herein incorporated by reference, and for the reasons discussed above distinguishing the presently claimed

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invention from the disclosure of Hartley, Applicants respectfully disagree with the Examiner's contention that the claims of the present invention are not patentably distinct from claims 27-39 of Hartley. Applicants therefore respectfully request that this rejection be reconsidered and withdrawn.

X. Other Matters

It has come to Applicants' attention that, on the Form PTO-1449 submitted with Applicants' Fifth Supplemental Information Disclosure Statement (IDS), the Examiner crossed through references AT117-AR119, indicating that "a website is not a reference." Similarly, on the PTO-1449 submitted with Applicants' Second Supplemental IDS, the Examiner initialed reference AS90, but also crossed through it. These citations indicate the date that the information was accessed from the publicly available web pages and provide the URL that links to the web page. Furthermore, printed copies of the web pages as accessed were submitted with the IDSs. Applicants respectfully request that, in all instances in the captioned application where the Examiner has not initialed the Form PTO-1449 for web page citations, he initials them and provides a copy of the initialed forms to Applicants.

XI. Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the

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outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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